

I. Claim 1 is Patentable Over Mitchell

Claim 1 recites:

A method comprising:

providing goods in reusable containers, said reusable containers having a radio frequency identification device attached thereto;

establishing a relationship between a radio frequency identification device and a memory;

providing said goods in said containers to customers;

collecting said reusable containers from said customers; and

identifying which customers have returned their reusable containers by electronically querying the radio frequency identification devices attached to the reusable containers.

Thus, one feature of this invention is that goods are provided in reusable containers to customers. The reusable containers are collected from the customers. The customers who have returned their reusable containers are identified by electronically querying a radio frequency device attached to the container. Mitchell neither teaches nor suggests this invention.

Mitchell merely applies RFIDs to containers used within factories. For example, he states:

In many systems and processes, such as in industrial and manufacturing processes, reusable containers are used to transport raw materials or finished goods or objects from an origin station to others, and in order for the personnel running the processes to be able to track and effectively utilize such reusable containers some sort of a labeling system is provided.

Mitchell col. 1, lines 7-13. At col. 1, lines 38-40, Mitchell teaches using the invention "with any suitable process for manufacturing or otherwise treating objects, goods, materials, products or the like." See also col. 3, lines 11-12. This neither teaches

nor suggests a) providing goods in reusable containers to customers; or b) tracking the return of reusable containers by customers using RFIDs.

In order for a reference to render obvious an invention, all claim limitations must be taught or suggested by the references. MPEP §2143.03. Nowhere does Mitchell teach or suggest applying RFIDs to packages that are sent to customers, nor does Mitchell teach or suggest having the customers return those packages, nor does Mitchell teach or suggest electronically querying the RFIDs to track the return of containers from the customers. Thus, claim 1 patentably distinguishes over Mitchell. The other claims distinguish over Mitchell for similar reasons.

II. The Alleged “Common Knowledge” Does Not Support the Obviousness Rejection.

A. The Alleged “Common Knowledge” Does Not Teach Or Suggest Limitations in Claim 1 Missing From Mitchell.

The Office Action admits that Mitchell fails to teach or suggest “identifying customers returning reusable containers.” The Office Action attempts to overcome this deficit by arguing:

However, tracking of which customers return goods has been common knowledge in the art, as is tracking a customers (sic) purchase habits, alerting customers when products have arrived for pick-up, making such products available and providing reduced shipping costs.

Office Action dated 10/19/05. §4. Even if the alleged common knowledge existed, it still would not render obvious Applicants’ claims. As mentioned above, in order for a reference to render obvious an invention, all claim limitations must be taught or suggested by the references. MPEP §2143.03. Applicants’ claim 1 recites “identifying which customers have returned their reusable containers by electronically

querying the radio frequency identification devices attached to the reusable containers.”

Even if the Examiner’s allegation of “common knowledge” were correct, it has nothing to do with whether it is known in the art to track **customers returning reusable containers** (including tracking return of reusable containers with an RFID.) Since Mitchell does not teach the above-quoted limitation, and the alleged common knowledge does not teach the above-quoted limitation, the combination of Mitchell and the alleged common knowledge cannot render obvious Applicants’ claim 1. (The other “common knowledge” alleged by the examiner is immaterial to claim 1.)

The 10/19/04 Office Action states: “Clearly, Mitchell’s RFID system may have accomplished the task of identifying customers.” Id. This is irrelevant and wrong. As mentioned above, Mitchell uses his RFID system in a factory. There is nothing to teach or suggest using RFIDs in any context in which a customer could be identified.

B. Applicants Traverse the Examiner’s Reliance on Common Knowledge.

Applicants traverse the Examiner’s allegations of common knowledge. Applicants are not aware of any common knowledge that can be properly combined with Mitchell. Applicants demand that the Examiner produce references teaching such common knowledge that can be combined with Mitchell or withdraw the rejection.

It may be that in some commercial settings, when a customer mails back a product to a manufacturer, he phones the manufacturer to get an RMA number (“return of material authorization number”), and references the RMA number in the cover letter or form accompanying the product. If that is what the Examiner refers to, it is completely irrelevant to claim 1. First, it has nothing to do with the use of a reusable container or the return of a reusable container. Second, it has nothing to do with RFIDs. Third, there is

nothing about this practice that can be combined with Mitchell. Mitchell does not teach sending anything to a customer, nor does he teach a customer sending anything to Mitchell. Accordingly, there is no reason why one skilled in the art would be motivated to modify Mitchell in light of this practice.

C. The Examiner's Reliance on Common Knowledge is Illegal.

Applicants remind the Examiner that “Official notice unsupported by the documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration** as being well-known.” MPEP §2144.03. Since the current official notice does not meet this standard it is illegal.

In a telephone interview on May 24, 2005, the Examiner stated that he did not know whether references of the nature described in his “official notice” existed. This is clear proof that the official notice is not capable of instant and unquestionable demonstration, and is therefore illegal.

III. Claim 6 Distinguishes Over Mitchell

Claim 6 recites:

Method of claim 5 wherein said customers return said reusable containers to a central collection point, said method further comprising querying the radio frequency identification devices within said containers when said customers return said containers to said collection point.

Again, Mitchell does not teach or suggest providing reusable containers to customers, having the customers return the reusable containers, or querying the RFIDs

when the customers return the containers. Therefore, Mitchell could not possibly render claim 6 unpatentable.

#### IV. Claim 7 and 9 Distinguish Over Mitchell

Claim 7 recites:

Method of claim 1 further comprising crediting accounts of those customers who return their reusable containers, said crediting being accomplished by a computer that receives the data scanned in from said radio frequency identification devices.

There is nothing in the cited art that teaches or suggests any of the acts described in claim 7. Therefore, claim 7 must be allowed. Claim 9 is similarly patentable over Mitchell.

#### V. Claim 18 Distinguishes Over Mitchell

Claim 18 recites:

A method comprising:

providing goods in reusable containers, said reusable containers having identification indicia attached thereto;

establishing a relationship between that indicia and a memory;

providing said goods in said containers to customers;

collecting information on the purchasing habits of said customers and storing said information in a memory device; and

offering a reduction of shipping cost in exchange for allowing targeted advertisement to be added to the reusable containers in response to said information in said memory device.

Mitchell neither teaches nor suggests providing goods in reusable containers to customers, collecting information on the purchasing habits of said customers, storing the information in a memory device, or offering the reduction of shipping cost. (The

Examiner does not allege Mitchell teaches these limitations.) Therefore, claim 18 must be allowed.

The Office Action alleges that it is common knowledge to track customer purchase habits (Office Action of 10/19/04, §4). It may be that when one buys a product from Amazon, Amazon keeps a record of what customers may purchase. If that is what the Examiner refers to, it is irrelevant to claim 18. First, that knowledge combined with Mitchell does not teach or suggest providing goods to customers in reusable containers. Second, there is no reason one would combine such a practice with Mitchell because Mitchell has nothing to do with customers. Third, the Examiner's reliance on common knowledge is illegal under MPEP §2144.03.

If the Examiner relies on "common knowledge" other than what is set forth above, the Examiner is requested to provide a reference describing what he refers to.

#### VI. Claim 19-24 Distinguish Over Mitchell

Claim 19 recites:

Method of claim 1 wherein said reusable containers contain one or more consumer products and are provided to the consumers of said consumer products in said containers.

Again, Mitchell does not teach or suggest that consumer products are shipped to consumers of those products in containers that comprise an RFID. Instead, Mitchell merely uses his RFIDs within the confines of a factory. Therefore, claim 19 distinguishes over Mitchell. Claims 20-24 distinguish over Mitchell for at least this reason as well.

#### VII. Claim 47 and 49 Distinguish Over Mitchell

Claim 47 recites:

Method of claim 29 further comprising:

electronically ordering from a plurality of different companies some of said goods, said ordering of said goods being accomplished by a customer;

shipping said goods to a distribution point for pick-up by said customer in response to said ordering.

The Office Action doesn't even attempt to point out where claim 47 is taught or suggested. Therefor, claim 47 must be allowed. Claim 49 distinguishes over Mitchell for similar reasons.

The Final Office Action states: "Regarding claims 47-49, these methods have been common knowledge within the shipping art." Applicants traverse the Examiner's reliance on alleged common knowledge. Applicants request that the Examiner provide a reference teaching this alleged common knowledge or withdraw the rejection. Further, Applicants point out that reliance on common knowledge on these circumstances is illegal. See MPEP §2144.03. Further, this is a new allegation of common knowledge. Therefore, it cannot be made in a final rejection.

### VIII. Claim 48 Distinguishes Over Mitchell

Claim 48 recites:

Method of claim 47 wherein said goods from said plurality of different companies ordered by said customer are provided in said one of said reusable containers, said customer picking up said goods at said distribution point.

Again, Mitchell has absolutely nothing to do with claim 48, and the Office Action doesn't even attempt to point out where the limitations of claim 48 could be found in the prior art.

IX. Wertenberger Isn't Prior Art

It is unclear whether the most recent Office Action rejects the claims over Wertenberger. In any event, Wertenberger is not prior art. It is based on a filing date that is subsequent to Applicants' filing date. Therefore, if this is a rejection it should be withdrawn.

Finally, Wertenberger is a new reference. It cannot be cited on a final rejection.

X. This Office Action Violates Numerous Rules of Patent Office Procedure

This is the sixth office action issued by the Patent Office. This is a textbook case of the "piecemeal prosecution" forbidden by MPEP §707.07(g).

As mentioned above, Mitchell was cited by the Examiner before. Applicants explained why Mitchell was inapposite. The Examiner agreed, and withdrew the rejection over Mitchell. In a telephone interview with the Examiner on November 3, 2004, Applicants pointed this out to the Examiner. The Examiner told Applicants' attorney that in the next office action response, he should simply point out that Mitchell was considered earlier during prosecution and he would withdraw the rejection. In light of this representation, the outstanding office action is uncalled for.

Also as mentioned above, the outstanding Office Action makes repeated references to "common knowledge". Applicants traverse each allegation of common knowledge. Each allegation violates MPEP §2144.03. Also, it is unclear what the Examiner refers to in his allegations of common knowledge. Applicants request that the Examiner cite publications in support of his allegations or withdraw the rejections,

For at least the foregoing reasons, the outstanding office action must be withdrawn and the application should be allowed.

Respectfully submitted,



Kenneth E. Leeds

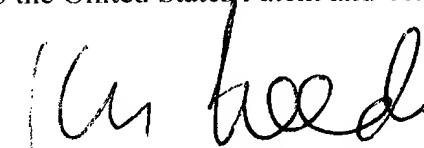
Reg. No. 30,566

Attorney for Applicants

Pursuant to rule 37 CFR 1.8(a), the undersigned attorney hereby certifies that this document is being sent by facsimile to the United States Patent and Trademark Office on July 29, 2005 to 703-872-9306.

July 28, 2005

Date

  
Signature